II. Remarks

A. Introduction

Reconsideration and allowance of the present application are respectfully requested.

Claims 34-45 are pending in the present application. Claim 34 is independent. Claim 34 has been amended. No claims have been added or cancelled. No new matter has been introduced.

B. Interview

Applicants thank the Examiner for the courtesies extended to Applicants' representative during the interview on January 2, 2008, in which the outstanding rejection was discussed. Applicants' separate record of the substance of the interview is contained in the comments below.

C. Claim Rejections

Claims 34-44 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,703,193 to Rosenberg, *et al.* ("Rosenberg"). Applicants respectfully traverse this rejection based on the amendments to claim 34 and for the reasons that follow.

1. Rosenberg Fails to Teach Every Claim Element under 35 U.S.C. § 102(b)

To reject a claim based on 35 U.S.C. § 102(b) all of the claim limitations must be taught by a single prior art reference. *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987) ("A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.").

Independent claim 34, as amended, recites "adding at least one polyol to a stoichiometric excess of a dissolved diphenylmethane diisocyanate monomer in a solution at an NCO:OH ratio in the range of from about 2:1 to 20:1, wherein the solution comprises the diphenylmethane diisocyanate monomer and ***one or more inert solvents consisting of solvents having a boiling point about 1°C to about 100°C below the boiling point of the diphenylmethane diisocyanate monomer at a pressure of 10 torr***." (Emphasis Added). The Office Action has not cited any

portion of Rosenberg or any other reference for teaching that the solvents are limited to only those having a lower boiling point as claimed. Instead, the Office Action alleges that "applicants' 'comprising' language causes the claims to be open to the inclusion of additional components and processing steps, including the use of the argued additional of [Rosenberg]." (*See* Office Action, page 3). The Federal Circuit has held that using "consisting of" in a clause limits only the elements of that cause. *See Mannesmann Demag Corp. v. Engineered Metal Products Co., Inc.*, 739 F.2d 1179, 1282 (Fed. Cir. 1986); *Berenter v. Quigg*, 737 F. Supp. 5, 7 (D.D.C. 1988) (finding that the Board's interpretation of "comprising" from a preamble as including additional steps to a clause limited by "consisting of" was too broad and inconsistent with *Mannesmann Demag*). The amendments to claim 34 clearly indicate that the solution comprises diphenylmethane diisocyanate monomer and one or more insert solvents ***consisting of*** solvents having a boiling point about 1°C to about 100°C below the boiling point of the diphenylmethane diisocyanate monomer at a pressure of 10 torr. Under the broadest ***reasonable*** interpretation of Claim 34, the comprising language of the preamble does not include other solvents which are clearly limited by the "consisting of" language. Any other interpretation ignores the well-established meaning of the transitional phrase "consisting of" and, thus, would be unreasonable. As amended, Rosenberg cannot teach or suggest that the one or more inert solvents consist of solvents having a lower boiling point than the diphenylmethane diisocyanate monomer as claimed. Therefore, for at least this reason, Rosenberg fails to teach every element of independent Claim 34 and Claim 34 is patentable over Rosenberg.

2. Dependent Claims

As indicated above, dependent Claims 35-44 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Rosenberg. Dependent Claim 45 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Rosenberg in view of U.S. Patent No. 4,624,996 to Rizk, et al. or U.S. Patent No. 4,101,473 to Lander. Dependent Claims 35-45 contain all the limitations of independent Claim 34 from which they depend and thus are patentable over the cited reference for at least the same reasons as independent Claim 34.

D. Conclusion

In view of the above remarks, it is believed that this application is in condition for allowance, and a Notice thereof is respectfully requested.

Applicants' undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 625-3536. All correspondence should continue to be directed to the below-listed address.

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